

REMARKS

Claims 1-6, 8-23, 25-43 and 50-58 are pending in the application. Claims 7 and 24 are currently canceled without prejudice. Claims 44-50 were previously canceled without prejudice. Claims 1, 2, 4, 11, 18, 21, 30, 39 and 51-55 are currently amended. New claims 57 and 58 are added. The amendments and new claims do not present any new matter. *See, e.g.*, Abstract (storage device can be attached to or positioned within a filter tray); para. 35 (filter stored in a filter tray may be marked with a bar-code or other identifier or code); para. 36 (bar-codes or identifiers on a filter); Figs. 1-2B. The amendments to claims 40, 53 and 54 address objections on page 2 of the Office Action. The amendments to claims 4, 21, 39 and 52-55 address the rejection under §112(f) on pages 2-4 of the Office Action. Reconsideration and allowance of the application, as amended, are respectfully requested.

I. The Rejection Under §102(e) Based on Morrison Is Moot

Independent claims 1, 18 and 51 and respective dependent claims 3, 6, 12, 20, 23, 29, 31, 35-37, 39, 40 and 52-55 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2004/0126281 A1 to Morrison (“Morrison”).

The rejection is moot in view of the Declaration of Patrick Guiney Under 37 C.F.R. §131 swearing behind Morrison, which is entitled to a priority date of August 26, 2003 under §102(e). The supporting exhibits A-C show that the subject matter of at least claims 1, 3, 6, 12, 18, 20, 23, 29, 31, 35-37, 39, 40 and 51-55 was conceived by Patrick Guiney prior to August 26, 2003. For the Examiner’s reference, Applicant respectfully submits copies of annotated Exhibits A and B including hand written numbers identifying sections of exhibits that expressly and/or inherently describe, relate to, and/or support various claims (identified by these numbers).

Accordingly, Applicant respectfully requests that the rejection of claims 1, 3, 6, 12, 18, 20, 23, 29, 31, 35-37, 39, 40 and 51-55 under 35 U.S.C. §102(e) based on Morrison be withdrawn.

II. Claims 1, 5, 11, 14, 15, 18, 22, 30, 31, 33, 34, 38, 39, 40 and 52-55 Are Novel Over Bailey

Independent claims 1, 18 and 51 and respective dependent claims 5, 11, 14, 15, 22, 30, 31, 33, 34, 38, 39, 40 and 52-55 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,635,403 to Bailey (“Bailey”). Applicant respectfully traverses the rejection.

In is implicitly conceded in the Office Action that Bailey fails to disclose, teach or suggest a data storage device attached to or positioned within the container as recited in claims 1 and 18 by not rejecting claims 7 and 24 based on Bailey. It is alleged in the Office Action that the sampling means or open face filter head 86 is the “container,” and the filter paper disc 102 is the “specimen filter” as recited in claims 1 and 18. However, the personal computer 90 is not attached to or positioned within the filter head 86.

Further, Bailey fails to disclose, teach or suggest “a biological specimen filter” as recited in claims 1 and 18, in combination with the other container and data storage device components recited in claim 1 and the other container, data storage device, processor and communications interface components recited in claim 18. Instead, Bailey is directed to a card for air filtration. Bailey (Abstract). More particularly, Bailey is directed to a card for detecting radioactive particulates or dust. Bailey (col. 1, lines 49-65; col. 6; lines 41-46). Radioactive particles and dust are not biological samples, and such cards for collecting radioactive particles and dust are not biological specimen filters. Bailey refers to liquid carriers having biological contaminants, but in the context of a dabber and a shallow dish, and explains that such materials are dried or admixed with clay or cellulose fiber to provide a semi-solid consistency for allowing attachment of the receptacle to the card. Bailey (col. 6, line 60). Thus, the “biological” application briefly mentioned by Bailey is not applicable to Applicant’s claims, which recite a “biological specimen filter” in combination with other apparatus and system components.

It is also alleged in the Office Action that dependent claims 52-55 are anticipated by Bailey, but the Office action does not address claim 51. Office Action (p. 6). In order for dependent claims 52-55 to be anticipated by Bailey, independent claim 51 must also be anticipated by Bailey. Nevertheless, Bailey does not anticipate claim 51 or claims 52-55 since Bailey fails to disclose, teach or suggest “a data storage device on the filter” and “wherein data related to the filter is stored in the data storage device to indicate whether the filter has been utilized” as recited in claim 51. As discussed above, it is alleged that that the computer 90 is the

“data storage device” as recited in the claims; however, it is clear that the computer 90 is not on the filter paper disc 102 (the alleged “filter”).

In view of these deficiencies, Applicant respectfully submits that Bailey is not relevant to Applicant’s independent claims 1, 18 and 51, and Applicant respectfully submits that claims 1, 18 and 51 are novel and non-obvious over Bailey. Dependent claims 5, 11, 14, 15, 22, 30, 31, 33, 34, 38, 39, 40 and 52-55 incorporate the elements and limitations of respective independent claims 1, 18 and 51 and, therefore, are also novel and non-obvious over Bailey. MPEP §2143.03.

Bailey also fails to disclose, teach or suggest “the stored data indicating a test or combination of tests that are compatible with the filter” as recited in claims 11 and 30. The Office Action relies on col. 7, lines 40-65 of Bailey, but this section merely describes how the card is used.

Regarding dependent claims 14, 15, 33 and 34, it is alleged in the Office Action that the test “could not be performed” if such data was not stored. However, Bailey sets forth steps performed by a user of the card. Bailey (col. 7, lines 37-62). Moreover, Bailey explains that data obtained during the test is transported “to” the computer means, not “from” the computer means. (Bailey, col. 7, line 58). Further, the Office Action has not established that the user of the card knows absolutely nothing about the test, and that all of the information required to perform the test is retrieved from a data storage device. Thus, the basis of the rejection is not clear since, as described by Bailey, the test can be performed without a data storage device storing data indicating a number of processing steps involving the filter or the specimen and one or more parameters of processing steps involving the filter or the specimen.

Accordingly, Applicant respectfully requests that the rejection of claims 1, 5, 11, 14, 15, 18, 22, 30, 31, 33, 34, 38, 39, 40 and 51-55 be under 35 U.S.C. §102(b) based on Bailey be withdrawn.

III. Claims 1-6, 11, 12, 14, 15, 18-23, 30, 31, 33, 34, 36, 38, 39-42, and 51-55 Are Novel Over McDevitt

Independent claims 1, 18 and 51 and respective dependent claims 2-6, 11, 12, 14, 15, 19-23, 30, 31, 33, 34, 36, 38, 39-42 and 52-55 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0045272 A1 to McDevitt *et al.* (“McDevitt”). Applicant respectfully traverses the rejection since McDevitt fails to anticipate any claim of the subject application.

Initially, McDevitt fails to disclose, teach or suggest “a data storage device attached to or positioned within the container” and “wherein data related to the filter is stored in the data storage device” as recited in claims 1 and 18. The Office Action does not identify any specific components described by McDevitt. Rather, the Office Action refers to five paragraphs of McDevitt. It is alleged in the Office Action that filtration of cellular material and proteins from bodily fluids (para. 464) discloses a “specimen filter” as recited in claims 1 and 18, and is apparently alleged that the “data storage device” as recited in these claims is either a barcode (as described in paras. 573 and 574) or a computer (as described in para. 438). Whichever interpretation is adopted, neither interpretation can support the rejection.

Initially, it is conceded in the Office Action that the bar code identifies the contents of the wells, *i.e.*, the analytes being tested, not the filter. Office Action (p. 7). McDevitt further explains that the barcode is used to “determine the identity of the sensor array without any input from the user.” McDevitt (para. 573). Accordingly, the barcode identified by the Office Action is not a data storage device “wherein data related to the filter is stored in the data storage device” as recited in claims 1 and 18 since the barcode is used to identify the sensor array, not a filter. The Office Action allegation is not clear since the barcode is not related to a filter.

Turning to the computer (para. 438), it is alleged in the Office Action that the device may be connected to a network of computers; however, para. 438 is clearly deficient relative to claims 1 and 18, each of which recites “a data storage device attached to or positioned within the container.” A computer would not be attached to or positioned within the container as recited in these claims. Moreover, McDevitt does not disclose, teach or suggest that data related to the filter is stored in a data storage device.

McDevitt also fails to disclose, teach or suggest “a data storage device on the filter” as recited in claim 51. Rather, as discussed above, the Office Action refers to a barcode on a sensor array (which is not a filter) and a network of computers. McDevitt also fails to disclose, teach or

suggest “wherein data related to the filter is stored in the data storage device” and fails to disclose, teach or suggest data related to the filter “to indicate whether the filter has been utilized.”

In view of these deficiencies, Applicant respectfully submits that independent claims 1, 18 and 51 are novel and non-obvious over McDevitt. If the rejection stands, Applicant respectfully requests the Examiner to specifically identify, by paragraph and line number, the specific components described by McDevitt that correspond to the specific limitations of claims 1, 18 and 51. Dependent claims 2-6, 11, 12, 14, 15, 19-23, 30, 31, 33, 34, 36, 38, 39-42 and 52-55 incorporate the elements and limitations of respective independent claims 1, 18 and 51 and, therefore, are also allowable. MPEP §2143.03.

Accordingly, Applicant respectfully requests that the rejection of claims 1-6, 11, 12, 14, 15, 18-23, 30, 31, 33, 34, 36, 38, 39-42 and 51-55 based on McDevitt be withdrawn.

IV. Claims 16, 17, 35, 43 and 56 Are Patentable Over McDevitt

Dependent claims 16, 17, 35, 43 and 56 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over McDevitt. Dependent claims 16, 17, 35, 43 and 56 incorporate the elements and limitations of respective independent claims 1, 18 and 51 and, therefore, are also allowable in view of the deficiencies of McDevitt discussed above. MPEP §2143.03.

V. Claims 8-10 and 25-28 Are Patentable Over McDevitt and Marsh

Dependent claims 8-10 and 25-28 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over McDevitt in view of U.S. Patent No. 5,219,294 to Marsh *et al.* (“Marsh”). Marsh is cited for the limited purpose of allegedly disclosing certain connectors. Marsh, however, does not cure the deficiencies of McDevitt. Accordingly, the rejection cannot stand. MPEP §2143.03.

VI. Claims 13, 16, 32 and 35 Are Patentable Over Bailey

Dependent claims 13, 16, 32 and 35 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bailey. Dependent claims 13, 16, 32 and 35 incorporate the elements and limitations of respective independent claims 1, 18 and 51 and, therefore, are also allowable in view of the deficiencies of Bailey discussed above. MPEP §2143.03.

VII. Claims 16, 17, 35, 43 and 56 Are Patentable Over Morrison

Dependent claims 16, 17, 35, 43 and 56 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Morrison. The rejection is moot in view of the Declaration of Patrick Guiney Under 37 C.F.R. §131 swearing behind Morrison.

CONCLUSION

Applicant respectfully requests entry of this Amendment, and submits that doing so will place the application in condition for allowance in view of the forgoing amendments and remarks. If there are any remaining issues that can be resolved by telephone, Applicant invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: June 11, 2007

By: / Gary D. Lueck /

Gary D. Lueck
Reg. No. 50,791
Attorneys for Applicant

12930 Saratoga Avenue, Suite D-2
Saratoga, California 95070
Telephone: (408) 777-2905
Facsimile: (408) 877-1662